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Docket No. AUS92001826US1 Serial No. 10/015,264 Atty: AJP

Applicant: BROWN ET AL

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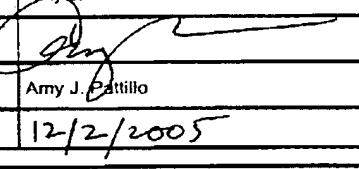
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Filing Date	12/12/2001
First Named Inventor	Brown et al.
Art Unit	2842
Examiner Name	Ubiles, Marie C

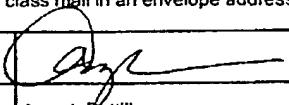
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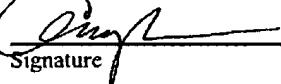
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of Michael Wayne Brown, et al. Serial No.: 10/015,264 Confirmation Number: 1742 Filed: 12/12/2001 Title: PROMOTING CALLER VOICE BROWSING IN A HOLD QUEUE	: Before the Examiner: : Tieu : Group Art Unit: 2642 : IBM Corporation (AP) : (c/o) Amy J. Pattillo : P.O. Box 161327 : Austin, Tx 78716
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APPEAL BRIEF UNDER 37 CFR §41.37

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This Appeal Brief is submitted in support of the Appeal in the above-referenced application pursuant to a Notice of Appeal filed October 5, 2005 as required by 37 C.F.R. 41.31. This is an appeal from a final rejection dated July 7, 2005 of claims 1-29 of application serial number 10/015,264, filed December 12, 2001.

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I. Real Party in Interest

The real party in interest in the present application is the Assignee, International Business Machines Corporation of Armonk, New York, as evidenced by the Assignment set forth at Reel 012380, Frame 0766.

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II. Related Appeals and Interferences

In a related application US Patent Publication 2003/0108162, assigned to International Business Machines Corporation, Appellants filed a Notice of Appeal on November 14, 2005.

In a related application US Patent Publication 2003/0108187, assigned to International Business Machines Corporation, Appellants filed a Notice of Appeal on November 29, 2004, an Appeal Brief on January 31, 2005 and a Supplemental Appeal Brief on August 27, 2005.

In a related application US Patent Publication 2003/0108186, assigned to International Business Machines Corporation, Appellants filed a Notice of Appeal on June 17, 2004 and an Appeal Brief on August 17, 2004.

There are no additional Appeals or Interferences known to Appellant, Appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. No decisions have been rendered by a court or the Board at this time in any related applications.

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III. Status of Claims

1. Status of All Claims in Application

- a. Claims Rejected: 1-54
- b. Claims Allowed or Confirmed: None
- c. Claims Withdrawn from Consideration: None
- d. Claims Objected to: None
- e. Claims Cancelled: None

2. Claims on Appeal

- a. The claims being appealed are: 1-29
- b. The claims being appealed stand finally rejected as noted by the Examiner in the Examiner's Action dated July 7, 2005. These rejected claims which form the basis of this appeal are reproduced in the attached Appendix.

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IV. Status of Amendments

In Appellants' response dated September 7, 2004, Appellants amended claims 1, 12, and 23. The Examiner noted entry of the amended claims in the Office Action dated January 21, 2005.

No amendments after the Office Action dated July 7, 2005, finally rejecting claims 1-29, were presented.

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V. Summary of Claimed Subject Matter

Claim 1 is directed to a method for promoting voice browsing to a caller waiting in a hold queue. (Specification, paragraph 0016, Figure 2, elements 42, 46). At least one web page is selected from among multiple accessible web pages for selection for voice browsing by a particular caller waiting in a hold queue. (Specification, paragraph 0017, lines 1-3, paragraphs 0109, 0144, Figure 7, elements 92, 94, 96, Figure 10, elements 164, 166). The caller waiting in the hold queue is offered an incentive to voice browse the selected web page, where the incentive is a value redeemable in a transaction independent of the caller waiting in the hold queue. (Specification, paragraph 0017, lines 3-6, paragraphs 0032, 0115, 0116, 0126, 0144, 0147, Figure 10, elements 164, 166).

Claim 2 is directed to the method of claim 1 including a method for translating a web script of one of the selected web pages the caller selects for voice browsing into audio for output to the caller. (Specification, paragraphs 0031, 0098, 0146, Figures 2 and 3, elements 8a, 46, Figure 3, elements 58, 60, Figure 10, element 174).

Claim 3 is directed to the method of claim 1 including a method for providing the incentive for the caller for redemption during the call, responsive to the caller selecting to voice browse at least one of the selected web pages. (Specification, paragraphs 0115, 0116, 0147).

Claim 4 is directed to the method of claim 1 including a method for providing the incentive for storage in a caller profile associated with the caller, responsive to the caller selecting to voice browse at least one of the selected web pages. (Specification, paragraphs 0119, 0147, Figure 4, element 80, Figure 5, element 90, Figure 10, element 176). The caller is enabled to redeem the incentive from the caller profile in a future transaction. (Specification, paragraph 0116).

Claim 5 is directed to the method of claim 1 where the incentive offered to the caller includes at least one of an on hold advancement token, membership points, an electronic discount, and a cash value. (Specification, paragraph 0036, Figure 5, element 90).

Claim 6 is directed to the method of claim 1 including a method for receiving the call from a particular caller in the hold queue (Specification, paragraphs 0073, 0084, Figure 4, elements 76a-76n, Figure 9, elements 132, 138), authenticating the identity of

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the caller (Specification, paragraph 0018, lines 1-3, paragraph 0033, lines 5-8, paragraphs 0047, 0065, 0066, Figure 8, element 106), positioning the call in the hold queue (Specification, paragraphs 0084, 0139, Figure 9, element 142), retrieving a caller profile associated with the authenticated identity of the caller (Specification, paragraph 0018, lines 3-4, paragraph 0033, lines 1-5, paragraphs 0087, 0142, Figure 8, element 110) and selecting at least one web page from among multiple accessible web pages for the caller to voice browser according to the caller profile (Specification, paragraphs 0118, 0144, Figure 10, elements 164, 166).

Claim 7 is directed to the method of claim 1 including a method for selecting at least one web page from among the multiple accessible web pages in view of the selection of the multiple accessible web pages already accessed by the caller via a web browser. (Specification, paragraphs 0090, 0091, Figure 10, element 164).

Claim 8 is directed to the method of claim 1 including a method for selecting at least one web page from among multiple accessible web pages according to at least one from among a caller profile retrieved for the caller, a subject of the call specified by the caller, and general web page selections. (Specification, paragraph 0033, lines 1-5, paragraphs 0034, 0109, Figure 10, element 164).

Claim 9 is directed to the method of claim 1 where the web page is provided to aid the caller in solving a question that is the basis of the call. (Specification, paragraphs 0034, 0109, 0111, 0122, Figure 7, elements 92, 94, and 96, Figure 10, element 164).

Claim 10 is directed to the method of claim 1 where the web page is provided to advertise a product to the caller. (Specification, paragraphs 0035, 0091, 0112, 0123).

Claim 11 is directed to the method of claim 1 where the web page is received from a third party vendor to advertise a product to the caller. (Specification, paragraphs 0035, 0091, 0113, 0114, 0124).

Claims 12-22 are directed to a system with means for performing the elements described in claims 1-11. In particular, Figures 2, 3, and 4 illustrate a voice browser 46, which provides the means for performing the elements described in claims 12-22. With regard to claim 15, Figure 2 includes a caller profile server 50 for storing an incentive in a caller profile, where the caller is enabled to redeem the incentive from the caller profile accessed from caller profile server 50 in a future transaction. With regard to claim 16,

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Figure 4 includes an on hold system 42, at which calls are received, and call hold queues 76a-76n, into which a call is positioned.

Claims 23-29 are directed to a computer program product for performing the steps described in claims 1-4 and 6-8. In particular, the specification describes that while the invention is described with reference to a data processing system, the computer readable medium of Claims 23-29 is taught where the recordings, which are the means for performing the elements of claims 1-4 and 6-8 can all be distributed through a "computer readable medium of instructions and a variety of forms" (Specification, paragraph 0149). Examples of a recording medium include:

"recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and transmission-type media, such as digital and analog communications links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions" (Specification, paragraph 0149, lines 10-15).

In addition, the recording medium may "take the form of coded formats that are decoded for actual use in a particular data processing system" (Specification, paragraph 0149, lines 15-17).

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VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 1-8, 10-19, and 21-29 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker et al. (US Patent 6,178,240).
2. Claims 9 and 20 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker et al. (US Patent 6,178,240) in view of Uppaluru (US Patent 5,915,001).

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VII. Argument

1. 35 U.S.C. 103(a), Alleged Obviousness, Claims 1-4, 6-8, 11-15, 17-19, 21-29

The Final Office Action rejects claims 1, 12, and 23 under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (US Patent Number 6,178,240) (hereinafter also referred to as Walker). [Final Office Action, p. 2] The rejection is respectfully traversed.

Independent method claim 1, which is representative of independent system claim 12 and independent computer program product claim 23, with regard to similarly recited subject matter and rejection, reads as follows:

1. A method for promoting voice browsing, comprising:
 - selecting at least one web page from among a plurality of accessible web pages for voice browsing by a particular caller waiting in a hold queue; and
 - offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue.

In the rejection of claims 1, 12, and 23, the Examiner states that these claims are rejected for the same reasons as stated in the Office Action mailed 1/21/2005. [Final Office Action, p. 2] In the Office Action mailed 1/21/2005, the Examiner stated that as to claim 1, the Examiner stated that “previously claimed limitations are rejected for the same reasons as stated in the Office Action mailed 6/4/2004.” [Office Action, p. 2] In particular, the “previously claimed limitations” from the Office Action dated 6/4/2004 refers the Examiner’s previous rejection of selecting at least one web page from among a plurality of accessible web pages for voice browsing by a particular caller waiting in said hold queue under the abstract, lines 1-3 and col. 6, lines 12-32 of Walker. [Office Action dated 6/4/2004, p. 2]

In response to the Office Action dated 6/4/2004, Appellants amended claim 1 to teach the amended element of offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue. Responsive to the amendment, in the Office Action of 1/21/2005, with regard to the amended element of claim 1, the Examiner states:

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In regards to the newly introduced limitations that recite "an incentive to voice browse" and "wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue" reads on the teaches of Walker et al. regarding the use of a flag on the customer profile indicating the denial of complimentary entertainment options to fraudulent customers (See, for example, col. 8, lines 10-13).

It would have been obvious to one of ordinary skill that returning preferred customers will be offered complimentary paid entertainment services (i.e. voice web browsing) on subsequent calls to the call center, their good standing is reflected on the caller profile. The claimed "value redeemable in a transaction independent of said particular caller waiting in said hold queue" reads, for example, in a complimentary service offered to a returning customer in good standing (i.e. with no flag). As taught by Walker et al., the complimentary service is denied to customers who have previously made fraudulent usage, the term "previously" implies a past transaction, therefore; it would have been obvious to one of ordinary skill that the decision to offer the complimentary service was based on an independent transaction performed by the customer currently in a hold queue. The limitation stating that "an incentive" is offered "to voice browse" reads on the implied action of the caller accepting the complimentary service. [Office Action dated 1/21/2005, pp.2-3]

Additionally, in response to Appellants' arguments presented on 9/7/2004, the Examiner states the following response to Applications previous assertion that the rejection of claim 1 is not well founded:

Regarding claims 1-4, 9, 12-15, 20, 23-26, the Applicant argues that Walker et al. ('240) "merely teaches offering the complimentary service, but does not teach offering a redeemable incentive for the user waiting on hold to use the complimentary service". Claims are rejected for the reasons discussed in the body of the rejection above. Further, Examiner respectfully disagrees with the definition of "incentive" as explained by Application in page 21 of Amendment dated 9/7/2004. The Applicant note that "incentive" does not equate offering a "complimentary service". The word "incentive" is defined as "a reward [something given or received in recompense for worthy behavior]" (See The American Heritage College Dictionary, 4th Ed) and "complimentary" as "[something] given free to repay a favor"; in Walker's system, the "complimentary service" is offered to customers in good standing (i.e. not flag), therefore as means to reward customer's previous actions." [Office Action dated 1/21/2005, pp. 7-8]

The Examiner carries the burden of proving a *prima facie* case of obviousness for a 103(a) rejection. Appellants respectfully assert that the Examiner does not carry the

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burden of proving a prima facie case of obviousness as to claim 1 for the following reasons.

Walker et al does not teach or suggest all the limitations of Claims 1, 12, and 23

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In particular, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratosflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants respectfully note that the Examiner does not show, nor do the references teach or suggest, separately or in combination, offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue because neither the Examiner's Arguments nor Walker show how Walker teaches both "offering an incentive to voice browse said at least one web page" and "offering an incentive that is redeemable in a future transaction independent of waiting in the hold queue."

First, Walker does not teach or suggest offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue because Walker does not offer an "incentive to voice browse said at least one web page". In the Office Action, the Examiner rejects claims 1, 12 and 23 by defining "incentive" as follows: "The word "incentive" is defined as "a reward [something given or received in recompense for worthy behavior]" (See The American Heritage College Dictionary, 4th Ed) and "complimentary" as "[something] given free to repay a favor". [Office Action dated 1/21/2005, p. 8] In addition, based on the Examiner's definition of "incentive", the Examiner asserts that "in Walker's system, the "complimentary service" is offered to customers in good standing (i.e. not flag), therefore as means to reward customer's previous actions." [Office Action dated 1/21/2005, p. 8] Appellants note

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that the Examiner must review claim 1 as a whole and that claim 1, when reviewed as a whole, teaches an incentive “**to voice browse**”. Even putting the Examiner’s argument in the most favorable light, the Examiner’s argument only describes Walker as teaching an incentive to not abuse the service. Appellants assert that an incentive to not abuse a service is not an incentive to voice browse.

Second, Walker does not teach or suggest offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue because Walker does not offer an “incentive to voice browse said at least one web page”. The Examiner cites “an incentive to voice browse” and “wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue” as reading on the disclosure in Walker of a flag field in a customer account that is set to indicate what type of access to offer the caller to entertainment services, if access is offered. [Office Action dated 1/21/2005, p. 2] The Examiner does not cite what element of claim 1 is not taught by Walker, but then cites two different rationales for why the amended claim elements would be obvious in view of Walker’s teaching of a flag field. [Office Action dated 1/21/2005, pp. 2, 3] In both of the rationales, the Examiner concludes that it would be obvious based on Walker’s teaching of a flag system to track whether a customer is fraudulent or good, to offer customers in good standing with complimentary services while on hold in future calls, but not to offer that service to customers waiting on hold who have previously abused the complimentary service while on hold. [See Office Action dated 1/21/2005, pp. 2, 3] The Examiner’s arguments, however, are based on the assertion that an “incentive” is the failure to impose a punishment. When claim 1 is considered as a whole, however, the “incentive” of claim 1 is focused on encouraging the new behavior of motivating the caller to use the voice browser instead of waiting for a call center operator. The “incentive” of claim 1, contrary to the Examiner’s assertions, is not taught by Walker’s flag based system of tracking whether or not to impose punishment on a caller for bad behavior.

Third, Walker does not teach offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable

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in a transaction independent of said particular caller waiting in said hold queue because Walker does not teach or suggest both offering the caller an incentive to voice browse and offering the caller an incentive with a redeemable value in a future transaction independent of when the caller waits in the hold queue. In particular, Walker discloses offering callers waiting on hold access to paid entertainment services. *Walker*, Abstract and col. 2, lines 17-52. Thus, Walker discloses offering a service to a caller on hold. Some callers may be offered complimentary access to the paid entertainment services. *Walker*, col. 2, lines 40-45. Walker does not teach both offering an entertainment service to callers on hold and offering an incentive to use the service to callers on hold, where the incentive has a redeemable value in a future transaction independent of the caller waiting in the hold queue. Further, in the rejection of Claim 1 where the Examiner argues that “offering an incentive to voice browse” reads on “the implied action of the caller accepting the complimentary service” the Examiner also assumes the incentive being that the service is free. [Office Action dated 1/21/2005, page 3]. In contrast, the present invention teaches offering a voice browsing service to a caller on hold and offering an incentive to the caller to use the voice browsing service while on hold, where the incentive has a redeemable value in a future transaction independent of the caller waiting in a hold queue.

In conclusion, a prima facie case of obviousness under 103(a) is not established for claim 1 because at least one element of claim 1 is not taught by Walker. Because a prima facie case of obviousness under 103(a) is not established for the claim 1, Appellants respectfully request allowance of claims 1, 12, and 23.

There is no suggestion or motivation to modify Walker

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Walker must come from the teachings of Walker, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Appellants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947

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F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Appellants respectfully note that the Examiner does not show, nor does Walker teach, a suggestion or motivation to modify Walker to teach offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue.

Walker discloses a call center where a caller is provided access to paid entertainment services while on hold. *Walker*, Abstract and col. 2, lines 17-52. Particular callers may be provided complimentary access to the paid entertainment services. *Walker*, col. 2, lines 40-45. The Examiner's statements as to what would have been obvious to one of ordinary skill in view of Walker's teachings focus determining whether to offer complimentary access to paid entertainment services to a caller on hold in the future based on the performance of the caller while on hold in the past. [See Office Action, pp. 2, 3]. The Examiner asserts that "previously" in Walker's teaching of "previously made fraudulent usage" implies a past transaction. As previously asserted, any past transactions by a user that are labeled as "previously made fraudulent usage" are expressly taught by Walker as the previous use, by a caller waiting on hold, of complimentary paid entertainment services, followed by the caller hanging up when an attendant is available to take the call. [Office Action, p. 3] Neither Walker nor the Examiner disclose, however, a teaching that suggests modifying Walker to both provide access to complimentary paid services to a caller waiting on hold and provide an incentive to use the service, where the incentive has a redeemable value in a future transaction independent of the caller waiting in the hold queue. Further, neither Walker nor the Examiner disclose a teaching that suggests modifying Walker to provide an incentive to voice browse. Therefore, because there is no suggestion or motivation in the teachings of Walker or cited by the Examiner, to modify Walker to teach offering an incentive to voice browse, where the incentive has a redeemable value in a transaction independent of the caller waiting in the hold queue, a *prima facie* case of obviousness is

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not established in view of Walker for claim 1 and Appellants respectfully request allowance of claims 1, 12, and 23.

There is No Reasonable Expectation of Success in the Proposed Modification of Walker

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of Walker. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Appellants respectfully assert that there is no reasonable expectation of success in the proposed modification of Walker, where the proposed modification is what the Examiner states would be obvious to one with skill in the art in view of Walker.

Claim 1 teaches that a web page to offer to a particular caller to voice browse is selected and that the call center not only offers the caller access to the voice browsing of those web pages, but offers the caller an incentive to voice browse the pages, where the incentive has a redeemable value in a future transaction outside the caller waiting in the hold queue. The Examiner's explanation of what is obvious in view of Walker is a call center that offers an entertainment service to callers on hold and determines whether a caller is offered the service on a complimentary basis while currently on hold based on the caller's previous use of the complimentary paid service while previously on hold; the call center punishes callers who abuse the complimentary paid service by using the service and then hanging up when a call operator is available. [See Office Action, pp. 2, 3] There is no indication that Walker, or what would be obvious to one skilled in the art in view of Walker, teaches offering an incentive to voice browse or said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue. Thus, there is no reasonable expectation of success in the proposed modification of Walker and therefore no *prima facie* case of obviousness as to claim 1. Therefore, because there is no *prima facie* case of obviousness as to claim 1, Appellants respectfully request allowance of claims 1, 12, and 23.

In addition, Appellants respectfully assert that because the independent claims 1, 12, and 23 upon which these dependent claims 2-4, 6-8, 11, 13-15, 17-19, 21, 22, and 24-

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29 rely are not obvious in view of Walker, then the dependent claims 2-4, 6-8, 11, 13-15, 17-19, 21, 22, and 24-29 are also not obvious in view of Walker and the dependent claims should be allowed.

2. 35 U.S.C. 103(a), Alleged Obviousness, Claims 5 and 16

The Final Office Action rejects 5 and 16 under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (US Patent Number 6,178,240) (hereinafter also referred to as Walker). [Final Office Action, p. 2]

Dependent method claim 5, which is representative of dependent system claim 16, with regard to similarly recited subject matter and rejection, reads as follows:

5. (Original) The method for promoting voice browsing according to claim 1, wherein said incentive comprises at least one from among an on hold advancement token, membership points, an electronic discount, and a cash value.

First, Appellants respectfully assert that because the independent claims 1 and 12 upon which these dependent claims 5 and 16 rely are not obvious in view of Walker, then the dependent claims 5 and 16 are also not obvious in view of Walker and the dependent claims should be allowed.

Second, Appellants respectfully traverse the rejection of claims 5 and 16. In the rejection of claims 5 and 16, the Examiner states that these claims are rejected for the same reasons as stated in the Office Action mailed 1/21/2005. [Final Office Action, p. 2] In the Office Action mailed 1/21/2005, the Examiner rejects claims 5 and 16 on the ground that “said incentive comprising at least membership points” reads for example on a returning customer in good standing able to use the complimentary service, offering “complimentary service” to a returning customer, for example, in well-known preferred customer programs. [Office Action dated 1/21/2005, p. 3] In the Appellants’ response dated 4/15/2005, Appellants requested that the Examiner support the grounds of rejection as to what is “well-known” through proper documentary evidence as required under MPEP 2144.03 and 37 CFR 1.104(c)(2). In the Final Office Action, the Examiner cites Walker et al. (US 6,018,718) and states that Walker et al “teaches the well-known ‘customer program’ in Col. 2, line 57 through col. 3, line 2.” [Final Office Action, p. 4]

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**Walker in view of Walker (6,018,718) does not teach or suggest all the limitations of
Claims 5 and 16**

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Appellants respectfully assert that claims 1 and 12, when considered as a whole, are not taught or suggested by Walker, and that Walker in view of Walker et al. (US 6,018,718) does not fix the shortcomings of Walker and therefore the combination of Walker and Walker et al. (US 6,018,718) does not teach all the elements of claims 5 and 16.

In the rejection of claims 5 and 16, the Examiner cites col. 2, line 57 – Col. 3, line 2 of Walker (US 6,018,718) which reads:

Recently, some credit card issuers have implemented specialty programs which are tailored to a particular group of card holders. GE Capital, for example, has introduced “GE Capital Gains Card” which is a travel and entertainment card that rewards card holders for saving rather than spending money. GE offers a card holder bonus points redeemable for airline tickets or gifts if the card holder conforms to behaviors identified by the card holder’s company. For example, if a card holder conforms to a corporate travel policy by flying with a preferred carrier or staying at a preferred hotel, the card holder will be awarded points. Such specialty cards have similar shortcomings to the accrual and tiered reward programs described above.

Appellants respectfully assert that because Walker does not teach or suggest an “incentive to voice browse”, even though Walker et al. (US 6,018,718) may teach offering a card holder membership points, Walker et al. (US 6,018,718) does not teach or suggest offering a card holder membership points as an incentive to voice browse and therefore Walker et al. (US 6,018,718) does not correct the shortcomings of Walker in failing to teach or suggest “offering an incentive to voice browse” in claims 1 and 12. In addition, because neither Walker or Walker et al. (US 6,018,718) teaches or suggests an “incentive to voice browse”, the combination of Walker and Walker et al. does not teach the “incentive to voice browse comprising membership points.”

In conclusion, a prima facie case of obviousness under 103(a) is not established for claims 5 and 16 because at least one element of claims 5 and 16 is not taught by

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Walker, even in view of Walker (US 6,018,718). Because a prima facie case of obviousness under 103(a) is not established for the claims 5 and 16, Appellants respectfully request allowance of claims 5 and 16.

3. 35 U.S.C. 103(a), Alleged Obviousness, Claims 9 and 20

The Final Office Action rejects claims 9 and 20 under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (US Patent 6,178,240) in view of Uppaluru (US Patent 5,915,001). [Final Office Action, p. 2] The rejection is respectfully traversed.

Dependent method claim 9, which is representative of dependent system claim 20, with regard to similarly recited subject matter and rejection, reads as follows:

9. (Original) The method for promoting voice browsing according to claim 1, wherein said at least one web page is provided to aid said particular caller in solving a question that is the basis of said call.

First, Appellants respectfully assert that because the independent claims 1 and 12 upon which these dependent claims 9 and 20 rely are not obvious in view of Walker, then the dependent claims 9 and 20 are also not obvious in view of Walker and the dependent claims should be allowed. In particular, Appellants respectfully assert that claims 1 and 12, when considered as a whole, are not taught or suggested by Walker, and that Walker in view of Uppaluru does not fix the shortcomings of Walker and therefore the combination of Walker and Uppaluru does not teach all the elements of claims 9 and 20.

Second, Appellants respectfully traverse the rejection of claims 9 and 20. To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify the reference. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438, 1442 (Fed Cir. 1991). The suggestion or motivation to modify Walker must come from the teachings of Walker, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Appellants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

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Appellants respectfully note that the Examiner does not show, nor does Walker provide, a suggestion or motivation to modify Walker to teach offering said particular caller an incentive to voice browse at least one web page, wherein said at least one web page is provided to aid said particular caller in solving a question that is the basis of said call.

In the final Action, the Examiner bases the rejection of claims 9 and 20 on the grounds stated in the action dated 6/4/2004. In the rejection of claims 9 and 20, the Examiner states that “Walker et al. discloses the system as claimed except for the limitation wherein at least one web page is provided to aid said particular caller in solving a question that is the basis of said call.” [Office Action dated 6/4/2004, page 7]. The Examiner cites Uppaluru as describing “a subscriber (i.e. caller) accessing voice web attributes based on the subscriber desire to, for example, querying a stock portfolio service page, the agent automatically fills in the subscriber appropriate attributes based on the query (See Description, col. 19, lines 5-23).” [Office Action dated 6/4/2004, page 7]. The Examiner concludes that “[i]t would have been obvious to one [of] ordinary skill to modify Walker’s et al. system by adding allowing the caller to voice browse information based on his or her query, as taught by Uppaluru; and thus in this manner allow the customer to get information relevant to his/her needs and interests.” [Office Action dated 6/4/2004, pp. 7-8].

As previously asserted, Walker only describes either offering a “complimentary service” or withholding the complimentary service to punish the caller. *Walker*, col. 2, lines 40-45. Thus, Walker does not teach or suggest offering an “incentive to voice browse”. Further, Walker describes a system that solves a problem of how to provide entertainment to a caller waiting on hold so the caller will wait on the line for a representative. *Walker*, col. 2, lines 7-30. Applicants respectfully assert that there is no motivation to modify Walker to fix the shortcomings of Walker in failing to teach or suggest an “incentive to voice browse”. In particular, there is no motivation taught or referenced in Walker or in the Examiner’s rejection to modify Walker’s entertainment service that punishes callers for abusing the free entertainment service designed to keep the caller waiting on hold long enough to speak to a call center operator to teach the claimed invention of providing the caller with a separate incentive to voice browse a web page to aid the caller in solving the question that is the basis of the call, to reduce the

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number of callers having to actually wait to talk with a representative to have a question answered.

Therefore, Appellants respectfully assert that because there is no suggestion or motivation in the teachings of Walker or cited by the Examiner, to modify Walker to teach offering said particular caller an incentive to voice browse at least one web page, wherein said at least one web page is provided to aid said particular caller in solving a question that is the basis of said call, a *prima facie* case of obviousness is not established in view of Walker for claims 9 and 20 and Appellants respectfully request allowance of claims 9 and 20.

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CONCLUSION

It is therefore respectfully requested that the Examiner's rejection of claims 1-29 under 35 USC 103(a) be reversed and the claims allowed.

Please charge the fee of \$500.00 for submission of an Appeal Brief under 37 CFR 41.20(b)(2) to IBM Corporation Deposit Account No. 09-0447. No additional filing fee is believed to be necessary; however, in the event that any additional fee is required, please charge it to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,



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VIII. Claims Appendix

The Claims involved in the Appeal are as follows:

1. A method for promoting voice browsing, comprising:

selecting at least one web page from among a plurality of accessible web pages for voice browsing by a particular caller waiting in a hold queue; and

offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue.

2. The method for promoting voice browsing according to claim 1, further comprising:

responsive to a selection by said caller to voice browse said at least one web page, translating a web script for at least one web page into audio output to said particular caller.

3. The method for promoting voice browsing according to claim 1, further comprising:

responsive to voice browsing of said at least one web page, providing said incentive for said particular caller for redemption during said call.

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4. The method for promoting voice browsing according to claim 1, further comprising:

responsive to voice browsing of said at least one web page, providing said incentive for said particular caller for storage in a caller profile associated with said particular caller, wherein said particular caller is enabled to redeem said incentive from said caller profile in a future transaction.

5. The method for promoting voice browsing according to claim 1, wherein said incentive comprises at least one from among an on hold advancement token, membership points, an electronic discount, and a cash value.

6. The method for promoting voice browsing according to claim 1, further comprising:

receiving a call from said particular caller at said hold queue;

authenticating an identity of said caller;

positioning said call in said hold queue;

retrieving a caller profile according to said authenticated identity of said caller; and

selecting said at least one web page from among said plurality of accessible web pages for browsing by said particular caller according to said caller profile.

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7. The method for promoting voice browsing according to claim 6, wherein selecting said at least one web page further comprises:

selecting said at least one web page from among said plurality of accessible web pages in view of a selection of said plurality of accessible web pages already accessed by said caller via a web browser.

8. The method for promoting voice browsing according to claim 1, wherein selecting at least one web page further comprises:

specifying said at least one web page according to at least one from among a caller profile retrieved for said particular caller, a subject of said call specified by said particular caller, and general web page selections.

9. The method for promoting voice browsing according to claim 1, wherein said at least one web page is provided to aid said particular caller in solving a question that is the basis of said call.

10. The method for promoting voice browsing according to claim 1, wherein said at least one web page is provided to advertise a product to said particular caller.

11. The method for promoting voice browsing according to claim 1, wherein said at least one page provided to advertise a product is received from a third party vendor.

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12. A system for promoting voice browsing, comprising:

a call center comprising a hold queue;

means for selecting at least one web page from among a plurality of accessible web pages for voice browsing by a particular caller waiting in said hold queue; and

means for offering said particular caller an incentive to voice browse said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue.

13. The system for promoting voice browsing according to claim 12, further comprising:

means responsive to a selection by said caller to voice browse said at least one web page, for translating a web script for at least one web page into audio output to said particular caller.

14. The system for promoting voice browsing according to claim 12, further comprising:

means responsive to voice browsing of said at least one web page, for providing said incentive for said particular caller for redemption during said call.

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15. The system for promoting voice browsing according to claim 12, further comprising:

means responsive to voice browsing of said at least one web page, for providing said incentive for said particular caller for storage in a caller profile associated with said particular caller, wherein said particular caller is enabled to redeem said incentive from said caller profile in a future transaction.

16. The system for promoting voice browsing according to claim 12, wherein said incentive comprises at least one from among an on hold advancement token, membership points, an electronic discount, and a cash value.

17. The system for promoting voice browsing according to claim 12, further comprising:

means for receiving a call from said particular caller at said call center;

means for authenticating an identity of said caller;

means for positioning said call in said hold queue;

means for retrieving a caller profile according to said authenticated identity of said caller; and

means for selecting said at least one web page from among said plurality of accessible web pages for browsing by said particular caller according to said caller profile.

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18. The system for promoting voice browsing according to claim 17, wherein said means for selecting said at least one web page further comprises:

means for selecting said at least one web page from among said plurality of accessible web pages in view of a selection of said plurality of accessible web pages already accessed by said caller via a web browser.

19. The system for promoting voice browsing according to claim 12, wherein selecting at least one web page further comprises:

means for specifying said at least one web page according to at least one from among a caller profile retrieved for said particular caller, a subject of said call specified by said particular caller, and general web selections.

20. The system for promoting voice browsing according to claim 12, wherein said at least one web page is provided to aid said particular caller in solving a question that is the basis of said call.

21. The system for promoting voice browsing according to claim 12, wherein said at least one web page is provided to advertise a product to said particular caller.

22. The system for promoting voice browsing according to claim 12, wherein said at least one page provided to advertise a product is received from a third party vendor.

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23. A computer program product for promoting voice browsing, comprising:

a recording medium;

means, recorded on said recording medium, for directing selection of at least one web page from among a plurality of accessible web pages for voice browsing by a particular caller waiting in said hold queue; and

means, recorded on said recording medium, for enabling an offering to said particular caller of an incentive for voice browsing said at least one web page, wherein said incentive comprises a value redeemable in a transaction independent of said particular caller waiting in said hold queue.

24. The computer program product for promoting voice browsing according to claim 23, further comprising:

means, recorded on said recording medium, for translating a web script for at least one web page selected by said particular caller into audio output directed to said particular caller.

25. The computer program product for promoting voice browsing according to claim 23, further comprising:

responsive to a selection by said caller to voice browse said at least one web page, for providing said incentive for said particular caller for redemption during said call responsive to said particular caller voice browsing said at least one web page.

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26. The computer program product for promoting voice browsing according to claim 23, further comprising:

responsive to a selection by said caller to voice browse said at least one web page, for providing said incentive for said particular caller for storage in a caller profile associated with said particular caller, wherein said particular caller is enabled to redeem said incentive from said caller profile in a future transaction.

27. The computer program product for promoting voice browsing according to claim 23, further comprising:

means, recorded on said recording medium, for enabling receipt of a call from said particular caller;

means, recorded on said recording medium, for authenticating an identity of said caller;

means, recorded on said recording medium, for controlling positioning of said call in said hold queue;

means, recorded on said recording medium, for initiating retrieval of a caller profile according to said authenticated identity of said caller; and

means, recorded on said recording medium, for selecting said at least one web page from among said plurality of accessible web pages for browsing by said particular caller according to said caller profile.

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28. The computer program product for promoting voice browsing according to claim 27, further comprising:

means, recorded on said recording medium, for selecting said at least one web page from among said plurality of accessible web pages in view of a selection of said plurality of accessible web pages already accessed by said caller via a web browser.

29. The computer program product for promoting voice browsing according to claim 27, wherein selecting at least one web page further comprises:

means, recorded on said recording medium, for specifying said at least one web page according to at least one from among a caller profile retrieved for said particular caller, a subject of said call specified by said particular caller, and general web page selections.

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IX. Evidence Appendix

There is no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner that is relied upon by Appellants in the appeal.

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X. Related Proceedings Appendix

There are no decisions rendered by a court or the Board in any related appeals.